



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,326	12/31/2001	Yukio Sawajiri	SAWAJIRI=2	4583

1444 7590 11/16/2004  
BROWDY AND NEIMARK, P.L.L.C.  
624 NINTH STREET, NW  
SUITE 300  
WASHINGTON, DC 20001-5303

EXAMINER

HO, THOMAS Y

ART UNIT PAPER NUMBER

3677

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/032,326

Applicant(s)

SAWAJIRI ET AL.

Examiner

Thomas Y Ho

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Status of Claims*

Claims 1-10 are currently pending. Claim 11 has been withdrawn or cancelled.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ichinose US6155618 in view of Mark GB2336178A, and further in view of Hamada US6042160.**

As to claim 1, Ichinose discloses, a striker of a vehicle door latch device, comprising: a longitudinal plate-like metal base 4 to be fixed to a vehicle body 2; and a U-shaped metal engaging member 5 including a first leg part 5A, a second leg part 5B which is in parallel with the first leg part, and a front connecting part 5C which connects a front end of the first leg part and a front end of the second leg part; the longitudinal axis of the front connecting part being perpendicular to the longitudinal axis of the metal base, wherein the longitudinal length of both the first leg part and the second leg part are perpendicular to the plane of the metal base (see Figure 7); each of said first leg part and said second leg part having, at rear end thereof which projects on a rear side of the base through a mounting hole (see Figure 7) of the base, a rear caulking flange with a larger diameter than that of the mounting hole engaged with a rear surface of the base; and a front caulking flange with a larger diameter than that of the mounting hole engaged on a front side of the base (the caulking flanges are the parts of the legs 5A and 5B that

Art Unit: 3677

extend over the surfaces of the base; see Figure 7); said first leg part having, at a front side portion thereof, a latch engaging part (the top portion of leg 5A is a latch engaging part; see Figure 7; col.2, ln.5-18) which is engageable with a latch 10 on the vehicle door latch device having a structure which is oriented on the latch to engage the latch engaging part (see Figure 7). The difference between the claim and Ichinose is the claim recites, a recess on the latch being the structure that engages the front side portion; and said first leg part having, at a rear side portion thereof, a reinforced large diameter part with a larger diameter than that of the latch engaging part between the front caulking flange of the first leg part and the latch engaging part; wherein a length of said reinforced large diameter part being 20% or more of the length of the first leg part.

Hamada discloses a vehicle door latch and striker similar to that of Ichinose (see Figures 6 and 11). In addition, Hamada clearly shows that the latch 14 has a recess to receive a front portion of the striker. Ichinose discloses a known latch, but fails to expressly show the recess on the latch (the examiner's position is that the recess is there, but obscured by the angle of viewing in Figure 7). It would have been obvious to one of ordinary skill in the art, having the disclosures of Ichinose and Hamada before him at the time the invention was made, to use as the latch of Ichinose, the latch and recess of Hamada, to obtain a latch. One would have been motivated to make such a combination because this type of latch and engagement are old and well known in the art, as disclosed by Ichinose (col.2, ln.5) and taught by Hamada.

Mark discloses a vehicle door striker similar to that of Ichinose. In addition, Mark further teaches said first leg part 18 having a reinforced large diameter part with a larger diameter than that of the latch engaging part 22 between the front caulking flange of the first leg part and the latch engaging part; wherein a length of said reinforced large diameter part being

Art Unit: 3677

20% or more of the length of the first leg part (see Figure 1). It would have been obvious to one of ordinary skill in the art, having the disclosures of Ichinose and Mark before him at the time the invention was made, to modify the first leg part of Ichinose to have a large diameter part, as in Mark, to obtain a reinforced striker leg. One would have been motivated to make such a combination because the ability to give substantial added strength and durability to the striker would have been achieved, as taught by Mark (pg.3, 3<sup>rd</sup> full paragraph).

As to claim 2, Ichinose discloses, wherein said second leg part has the same shape as said first leg part (see Figure 7).

As to claim 3, Ichinose discloses, wherein said latch engaging part (top portion of 5A) has the same diameter as said front connecting part 5C (see Figure 7).

As to claim 4, Mark teaches, wherein a tapered part is provided between said reinforced large diameter part and said latch engaging part 22 (see Figure 1).

As to claim 5, Mark teaches, wherein the length of said reinforced large diameter part is 25% or more of the length of said first leg part 18 (see Figure 1).

As to claim 6, Ichinose discloses, wherein said second leg part 5B has the same shape as said first leg part 5A, and said latch engaging part (top portion of 5A) has the same diameter as said front connecting part 5C. Mark teaches a tapered part is provided between said reinforced large diameter part and said latch engaging part 22 (see Figure 1).

As to claim 7, Mark teaches, wherein the length of said reinforced large diameter part is 25% or more of the length of said first leg part 18 (see Figure 1).

As to claim 8, Mark teaches, wherein the length of said reinforced large diameter part is 30% or more of the length of said first leg part 18 (see Figure 1).

As to claim 9, Mark teaches, wherein said reinforced large diameter part has a length of twice or more the length of said rear caulking flange, in the longitudinal direction of said first leg part (see Figure 1).

As to claim 10, Mark teaches, wherein said reinforced large diameter part has a length of triple or more the length of said rear caulking flange, in the longitudinal direction of said first leg part (see Figure 1).

### *Response to Arguments*

Applicant's arguments filed 8/16/04 have been fully considered but they are not persuasive.

The Applicant argues (p. 8) that the Mark reference discloses the limbs need to be bent as shown in the Mark drawings. The Examiner respectfully disagrees. The Mark reference does teach the reinforced leg design would be beneficial because would allow complex striker formations to be achieved. This is an argument for the combination of Ichinose and Mark rather than against it, because modifying the conventional striker in Ichinose with the reinforced legs in Mark would give the conventional striker the benefit of being able to be made into complex shapes. The Applicant focuses solely on the drawings of Mark, which show bent striker legs, and concludes from the drawings that the limbs need to be bent. Applicant is picking only one disclosed embodiment to argue upon, but the Mark reference must be analyzed as a whole. The drawings show a twisted configuration, but on page 2, first full paragraph, Mark also discloses that the limbs may be parallel to each other and they may be straight. Mark does not require that the striker legs are bent, but rather, discloses that the striker legs can be bent or straight.

The Applicant argues (p. 8) that the combination of Ichinose and Mark would not be obvious to the skilled artisan, especially in light of the indication in the last full paragraph of page 3 of Mark that the different features of Mark are intended for use in strikers other than conventional strikers such as Ichinose. The Examiner respectfully disagrees, and this is a mischaracterization of the cited portion in Mark. The last full paragraph of page 3 does not state, suggest, or imply the features of Mark are only intended for use in strikers other than conventional strikers. The last paragraph of page 3 is motivation that supports the combination of Ichinose and Mark. Ichinose discloses a conventional striker. The cited portion of Mark teaches why the reinforced leg portions of Mark are more desirable than the conventional leg portions of Ichinose. The cited portion of Mark begins by stating why the reinforced striker is more desirable than a conventional striker. Then the cited portion explains why a conventional striker is less desirable than a reinforced striker. Finally, the cited portion explains the benefits that the reinforced striker has over the conventional striker. Mark clearly discloses and suggests the structure and motivation to modify a conventional striker of Ichinose to have reinforced leg portions, and this motivations shows why the combination of Ichinose and Mark are based on the prior art and not on hindsight reasoning.

The Applicant argues (p. 9) there is no teaching the latch of Ichinose would necessarily engage its first leg above the large diameter portion as claimed, and so the combination is improper. The Examiner respectfully disagrees. The Applicant is claiming a striker, and any recitations in the claims directed to the latch hold little patentable weight because they are not part of the claimed invention. The limitation “engageable with...latch engaging part” in claim 1 holds little patentable weight because it is merely functional language. While features of an

Art Unit: 3677

apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971); In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). Furthermore, In response to applicant's argument that the latch in Ichinose would not engage above the large diameter portion, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

The Applicant argues (p. 10) that there is no teaching in the cited prior art of making the modified Ichinose legs the same shape. The Examiner respectfully disagrees. Ichinose itself discloses making the legs the same shape. Mark is not being used to teach modifying the straight legs of Ichinose to be bent and differently shaped. Mark is used as a teaching to make the part of a striker leg substantially greater in cross sectional area than that of the bolt engaging portion of the striker (pg. 1, fourth paragraph). Additionally, Mark does not disclose that the legs must be



Art Unit: 3677

bent, and states that the legs may be straight. Without the bends, the Mark striker would also have identical legs.

*Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Y Ho whose telephone number is (703)305-4556. The examiner can normally be reached on M-F 10:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J Swann can be reached on (703)306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3677

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TYH

  
ROBERT J. SANGER  
PRIMARY EXAMINER